

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-12 and 14 are presently active in this case. The present Amendment amends Claims 1-12; adds new Claim 14 without introducing any new matter; and cancels Claim 13 without prejudice or disclaimer.

The outstanding Office Action objected to Claims 1-12 because of informalities. Claims 1 and 6-9 were rejected under 35 U.S.C. §102(e) as anticipated by Okada et al. (U.S. Patent Publication No. 2003/0112340, herein "Okada"). Claims 2-3 were rejected under 35 U.S.C. §103(a) as unpatentable over Okada in view of Juen (U.S. Patent Publication No. 2002/0024602). Claims 4-5 were rejected under 35 U.S.C. §103(a) as unpatentable over Okada in view of Juen, further in view of de Queiroz et al. (U.S. Patent No. 6,058,210, herein "Queiroz"). Claim 11 was rejected under 35 U.S.C. §103(a) as unpatentable over Okada in view of Takashi et al. (Japanese Patent Publication No. JP 11-234624, herein "Takashi"). Claim 12 was rejected under 35 U.S.C. §103(a) as unpatentable over Okada in view of Greer et al. (U.S. Patent No. 4,959,622, herein "Greer"). Claim 10 was indicated as allowable if rewritten in independent form.

Applicant acknowledges with appreciation the indication of allowable subject matter.

In response to the Restriction Requirement being made final, Claim 13, directed to non-elected invention, is canceled. Applicant reserves the right to present claims directed to the non-elected invention in a divisional application, which shall be subject to the third sentence of 35 U.S.C. §121.¹

To vary the scope of protection recited in the claims, new Claim 14 is added. New Claim 14 depends upon Claim 1 and recites "the interface unit is further configured to output

¹ "A patent issuing on an application with respect to which a requirement for restriction under this section has been made ... shall not be used as a reference ... against a divisional application." See also MPEP 804.01.

the still picture in an uncompressed format.” New Claim 14 finds non-limiting support in the disclosure as originally filed, for example at page 8, lines 12-19. Therefore, the new claim is not believed to raise a question of new matter.²

Claim 1 is amended to recite “a multiplex unit configured to output the compressed motion picture and the still picture by time-division multiplexing” This feature finds non-limiting support in Applicant’s disclosure, for example at page 8, lines 9-23, and in corresponding Figure 1. In addition, Claims 1-12 are amended to better comply with U.S. claim drafting practice, to correct minor formalities and to overcome the objections to Claims 1-12 made by the outstanding Office Action.³ Since these changes are merely formal in nature, Applicant believes that the changes are not raising any question on new matter.

In light of the amendments to independent Claim 1, Applicant respectfully requests reconsideration of the rejections of Claims 1-9 and 11-12 under 35 U.S.C. §§102(e) and 103(a), and traverses the rejections, as discussed next.

Briefly recapitulating, Claim 1 relates to a digital camera, including, *inter alia*: a motion picture recording unit configured to obtain a motion picture by continuously recording the motion picture, a still picture recording/storage unit composed of a still picture recording unit configured to record a still picture by releasing a shutter and a picture storage unit configured to store the still picture, an interface unit configured to output the compressed motion picture data in an appropriate format and to output the still picture, and a ***multiplex unit configured to output the compressed motion picture and the still picture by time-division multiplexing.***

² See MPEP 2163.06 stating that “information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.”

³ See the outstanding Office Action at page 3, lines 7-16.

As explained in Applicant's specification at page 8, lines 9-19, Claim 1 improves upon background digital cameras, since subjects of a video conference can be recorded at high resolution, even when the video conference itself is operating in a low resolution mode.

Turning now to the applied references, Okada describes a digital camera, wherein when snapshot shooting is instructed during recording of a moving image, a shot still image is temporarily pushed aside in a memory area in a frame buffer.⁴ Okada explains that if a user want to take a still image (snapshot shooting) during the recording of a moving image, the still image is "pushed aside and stored in the memory area 7a."⁵ However, Okada fails to teach or suggest a multiplex unit configured to output the compressed motion picture and the still picture by time-division multiplexing, as confirmed by the outstanding Office Action.⁶

Okada points out to the reference Takashi, and states that "JP '624 teaches the compressed moving image data and the compressed still image data are subject to time division multiplex by a data multiplexer/demultiplexer circuit 16."⁷ Applicant respectfully disagrees, since Takashi reads data from an optical disk 22, and creates from the read data, being MPEG system Codec 12 data, moving image data and still image data. MPEG data recorded on a disk is moving image data. Takashi also states "the same moving image data are compressed every 9 frames by a JPEG CODEC 14 so that compressed still image data are generated."⁸ Accordingly, in Takashi, the still images are generated from a JPEG codec, and originate from the same data, being the MPEG data from an optical disk. In this regard, Takashi fails to teach or suggest a multiplex unit configured to output the compressed motion picture *and* the still picture by time-division multiplexing.

Since the remaining references Juen, Queiroz and Greer, relied upon by the outstanding Office Action to form 35 U.S.C. 103(a) rejections, fail to remedy the deficiencies

⁴ See Okada in the Abstract.

⁵ See Okada at page 5, paragraph 66, lines 1-14.

⁶ See the outstanding Office Action at page 8, lines 8-9.

⁷ See the outstanding Office Action on page 8, lines 9-12.

⁸ See Takashi in the Abstract.

of Okada and Takashi, the applied references fail to teach or suggest every feature recited in Applicant's claims, even in any proper combination. Therefore, Claims 1-12 and 14 are believed to be patentably distinct over the applied references, and Applicant respectfully traverses, and requests reconsideration of, these rejections.⁹

Applicant also respectfully submits that all the references relied upon by the outstanding Office Action to form the rejections fail to teach or suggest all the features of Applicant's dependent claims.

Regarding Claim 14, Okada fails to teach or suggest that the interface unit is further configured to output the still picture in an uncompressed format. Okada explains that if a user wants to take a still image (snapshot shooting) during the recording of a moving image, the still image is "pushed aside and stored in the memory area 7a."¹⁰ As further clearly shown in Okada, the input-output circuit 11 can access bus 13, and bus 13 is connected to the outputs of the JPEG core circuit and MPEG core circuit 5.¹¹ Okada explains at page 5, paragraphs [0061] and [0066] that, after the user sees the still image on the screen, the still image data is forwarded to a correcting circuit 4 for image correction, and subsequently input to the JPEG core circuit 5 for compression. Accordingly, Okada cannot output an uncompressed image, and therefore fails to teach or suggest the interface unit is further configured to output the still picture in an uncompressed format, as recited in new, dependent Claim 14. Since the remaining references also fail to teach or suggest such a feature, Applicant believes that new dependent Claim 14 also patentably defines over the applied references.

⁹ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

¹⁰ See Okada at page 5, paragraph 66, lines 1-14.

¹¹ See Okada's Figure 1

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-12 and 14 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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